UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,444	07/31/2001	Paul Dennis Stultz	M-11710 US	4212

27683 7590 04/20/2009
HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue
Suite 700
Dallas, TX 75219

EXAMINER	
PYZOCHA, MICHAEL J	
ART UNIT	PAPER NUMBER
2437	

MAIL DATE	DELIVERY MODE
04/20/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/919,444	STULTZ ET AL.	
	Examiner	Art Unit	
	MICHAEL PYZOCHA	2437	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *33-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 33-40 are pending.

2. Response filed 03/02/2009 has been received and considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 33, 35 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy et al. US (5978912) in view of NEC.

As per claim 33, Rakavy et al. discloses an information handling system (IHS) comprising: a processor; memory coupled with the processor; a display device coupled with the processor; a keyboard coupled with the processor (see FIG. 2); a basic input/output system (BIOS) coupled with the memory and the processor to operate in connection with devices other than an I/O controller (see column 1 line 64 through column 2 line 26), wherein the BIOS includes a power-on self-test (POST) procedure, wherein the POST procedure determines whether there is a problem with one or more components coupled with the IHS and alerts users to existing problems, and wherein the POST procedure terminates a BIOS procedure if the POST procedure determines that a problem with one or more components is a critical problem (see column 9 lines

34-40 and column 17 lines 55-60 where restarting the POST procedure terminates the current procedure and starts a new one).

Rakavy et al. fails to disclose a security system to limit entry to a function of the BIOS during the POST procedure, the security system comprising one or more sub systems to: enter a non-responsive mode where only one keyboard input from a plurality of possible keyboard inputs is recognized by the processor and wherein inputs from devices other than a keyboard are ignored; and wherein the one keyboard input from a plurality of possible keyboard inputs initiates a time delay for a password to enter a system setup.

However, NEC teaches such a security system (see pages 2-18 and 2-29).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the BIOS security system of NEC with the Rakavy et al. system.

Motivation, as recognized by one of ordinary skill in the art, would have been to increase the security.

As per claim 35, the modified Rakavy et al. and NEC system discloses wherein the devices other than a keyboard that are ignored include devices coupled via telephone circuits, intranets, local area networks and the Internet (see NEC page 2-18 and Rakavy et al. FIG 2).

As per claims 37-39, the modified Rakavy et al. and NEC system discloses preventing unauthorized users from entry to the RAID controller, NIC controller and virtual controller (see NEC pages 2-22 through 2-31 where all the controllers' settings are protected by the BIOS password).

5. Claims 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Rakavy et al. and NEC system as applied to claim 33 above, and further in view of Lin et al. (6192456).

As per claims 34 and 36, the modified Rakavy et al. and NEC system fails to disclose the use of SCSI and OPROM.

However, Lin et al. teaches the storing of BIOS code in the OPROM of a SCSI card (see column 1 lines 26-47).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for the modified Rakavy et al. and NEC system to include the SCSI card with OPROM and for it to be protected as above.

Motivation to do so would have been to allow the SCSI card to function as a boot device (see Lin et al. column 1 lines 26-47).

6. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Rakavy et al. and NEC system as applied to claim 33 above, and further in view of Beelitz et al. (US 6247126).

As per claim 40, the modified Rakavy et al. and NEC system fails to disclose preventing an unauthorized user from performing utility partition booting.

However, Beelitz et al. teaches such utility partitioning being enabled with BIOS keystrokes (see column 15 lines 14-24).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to protect the utility partitioning of Beelitz et al. with the modified Rakavy et al. and NEC system.

Motivation, as recognized by one of ordinary skill in the art, to do so would have been to allow only authorized users to allow partitioning and therefore multi booting.

Response to Arguments

7. Applicant's arguments filed 03/02/2009 have been fully considered but they are not persuasive. Applicant argues that none of the cited references teach terminating a BIOS procedure if the POST procedure determines that a problem with one or more components is a critical error and there is no motivation to combine NEC with Rakavy.

With respect to Applicant's argument that none of the cited references teach terminating a BIOS procedure if the POST procedure determines that a problem with one or more components is a critical error, Rakavy teaches entering a diagnostic state when the POST routine detects a critical error (see column 9 lines 34-40). As a part of the diagnostic state a number of functions are performed such as resetting the computer which re-executes the POST routines. When the computer is reset the BIOS procedure is terminated and restarted. Therefore, Rakavy teaches terminating a BIOS procedure if the POST procedure determines that a problem with one or more components is a critical error.

With respect to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to combine NEC with Rakavy as recognized by one of ordinary skill in the art would have been to increase the security.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL PYZOCHA whose telephone number is (571)272-3875. The examiner can normally be reached on Monday-Thursday, 7:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. P./
Examiner, Art Unit 2437

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437